

REMARKS

Applicant respectfully requests reconsideration of this application as amended. As a preliminary matter, in the Office Action mailed June 14, 2005, the Examiner did not attach an initialed copy of the PTO-1449 form references that were mailed to the PTO on May 21, 2003. Additionally, in the Office Action mailed December 7, 2004, the Examiner did not attach an initialed copy of the PTO-1449 form references (Other Art – No Patent Literature Documents section) that were mailed to the PTO on January 2, 2003. As such, applicant respectfully requests that the Examiner indicate that these references have been considered and made of record. The Examiner also did not indicate the references on said PTO-1449 form were not in conformance with MPEP 609. As such, applicant respectfully requests that the Examiner indicate that these references have been considered and made of record.

Office Action Rejections Summary

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,621,832 of Yokoyama ("Yokoyama").

Claims 2-3, 6 and 10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Yokoyama in view of Optics Guide 5 of Melles Griot ("Melles Griot").

Claims 13-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Yokoyama.

Status of Claims

Claims 1-22, 26-27 and 30-31 are pending in the application. No claims have been amended. No claims have been added. No new matter has been added. No claims have been canceled.

Claims 4-5 and 7-9 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

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limitations of the base claim and any intervening claims. Claims 11, 12, 17-22, 26, 27, 30 and 31 are allowed. Therefore, the following remarks are directed to the rejected claims.

Claim Objections and Rejections

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Yokoyama. It is submitted that claim 1 is patentable over Yokoyama.

Claim 1 recites:

An apparatus, comprising:

a housing having a plurality of at least four ports, each of the plurality of ports coupled to a corresponding one of a plurality of at least four fibers;

a plurality of collimating lenses disposed within the housing, each of the plurality of collimating lenses to receive a respective one of at least four light beams from a corresponding port of the plurality of at least four ports; and

a beamsplitter coupled to the plurality of collimating lenses to receive the light beam from each of the plurality of collimating lenses, the beamsplitter having a common optical aperture disposed on an outer surface area to simultaneously receive the four light beams, on the outer surface area of the common optical aperture, from each of the plurality of collimating lenses.

(emphasis added)

In regards to claim 1, the Office Action states:

a beamsplitter 34 coupled to the four collimating lenses to receive the light beam from each of the plurality of the collimating lenses, the beamsplitter having a common optical aperture disposed on an outer surface area to simultaneously receive the light received from each of the four lenses, on the outer surface area of the common optical aperture (lines 16-46, col. 4). It is noted that in both the device of Yokoyama depicted in Fig. 3, and the device of the claimed invention shown in Fig. 3, and the device of the claimed invention shown in Figs. 2-3, 10, light is received by more than one side of the beamsplitter, in other words the claim language reads on the device of fig. 3 in Yokoyama.

Regarding claim 1, and Applicant's argument that the beamsplitter in Yokoyama's device receives light from the input beams on different sides of the beamsplitter, as allegedly in contrast to the claimed invention, the examiner respectfully disagrees. **Observation of Figs. 2-3, 10 in the disclosure reveals that input light beams may enter the beamsplitter from different sides.**

(Office Action, 12/16/05, pages 2 and 4)(emphasis added).

Applicants respectfully submit that the Office Action's analysis is inapposite. The Examiner's observation regarding the applicant's specification provides no evidence of what is disclosed in Yokoyama. Rather, the Office Action must look to the disclosure of Yokoyama in determining whether the claim 1 limitations read on in Yokoyama, and must establish that all the limitations of the applicants' claim 1 are described by the cited reference of Yokoyama. A claim is anticipated only if each and every element as set forth in the claim is found in the cited prior art reference. MPEP 2131. It is respectfully submitted that the Office Action, here, has failed to establish where the claim 1 limitation of "a common optical aperture disposed on an outer surface area to simultaneously receive the four light beams" is disclosed in Yokoyama. The fact that the specification of the present application also describes an apparatus where "light is received by more than one side of the beamsplitter" (as asserted by the Office Action) does not cure this deficiency in Yokoyama.

It is submitted that the cited reference of Yokoyama fails to disclose the claim 1 limitation of a "beamsplitter having a common optical aperture disposed on an outer surface area to simultaneously receive the four light beams." As previously argued, in the optical coupler of Figure 3 of Yokoyama, incident beams from optical fibers 31a and 31c are directed to one side of the beamsplitter, while incident beams from optical fibers 31b and 31d are directed to the opposite side of the beamsplitter. (Yokoyama, col. 4, lines 16-33; fig 3). As such, only two of the four light beams may be received by either side of the beamsplitter. Therefore, Yokoyama does not disclose a beamsplitter having a common optical aperture disposed on an outer surface area to simultaneously receive the four light beams. Accordingly, under the rules, claim 1 is patentable over Yokoyama.

The Office Action's assertion that the specification of the present invention also describes an apparatus where "light is received by more than one side of the beamsplitter" does not cure Yokoyama's deficiency in failing to disclose a "beamsplitter having a common optical aperture disposed on an outer surface area to simultaneously receive the four light beams." For the sake of argument, even if claim 1 included a

limitation that light is received by more than one side of the beamsplitter, that does nothing to cure Yokoyama's deficiency in failing to disclose a beamsplitter having a common optical aperture disposed on an outer surface area to simultaneously receive four light beams. Therefore, it is submitted that claim 1 is patentable over Yokoyama.

Given that claims 4 and 5 depend from claim 1, it is also submitted that claims 4 and 5 are patentable over Yokoyama.

Claims 13-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Yokoyama. Claims 13-16 depend from and include the limitations of claim 1. It is submitted that Yokoyama does not teach or suggest that above noted claim 1 limitation and, therefore, claims 13-16 are patentable over Yokoyama.

Claims 2, 6 and 10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Yokoyama in view of Melles Griot. It is submitted that Optics Guide 5 of Melles Griot fails to cure the deficiency noted above in regards to claim 1 and, therefore, claims 2, 6 and 10 are patentable over the cited references.

Claim 3 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Yokoyama in view of Optics Guide 5 of Melles Griot ("Melles Griot"). It is submitted that claim 3 is patentable over the cited references.

The Office Action states:

Regarding claims 2-3, Yokoyama discloses all the limitations of the above claims except for teaching the use of a rhombic prism non-polarizing beamsplitter in place of the beamsplitter plate 34. The Optics Guide by Melles Griot shows typical non-polarizing beamsplitter cubes used in optics (p. 13-9 to 13-12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a beamsplitter cube instead of a beamsplitter plate in Yokoyama's device, since the latter comprises a plurality of dielectric layers deposited on a substrate, thus requiring a more complex manufacturing process.

Regarding claim 3, and the argument that the combination of Yokoyama and the Melles Griot reference is inappropriate, the examiner

notes that both references are from analogous art, and **substitution of the BS plate of Yokoyama with a BS prism would still result in the beam splitting operation disclosed by Yokoyama**, with the output beams separated and directed to respective optical fibers. BS cubes can be designed to output separate beams at predetermined intensity ratios, thus still fulfilling Yokoyama's stated object of the invention.

(Office Action, 12/16/05, pages 3 and 5)(emphasis added)

It is respectfully submitted that the Office Action's reasons are not sufficient to establish a case of obviousness. The mere fact that references can be combined or modified is not sufficient to establish *prima facia* obviousness unless the prior art also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01. Accordingly, the Office Action's stated reasons of "substitution of the BS plate of Yokoyama with a BS prism would still result in the beam splitting operation disclosed by Yokoyama" and "BS cubes can be designed . . ." are not sufficient to establish *prima facia* obviousness because the Examiner has not proved that the cited prior art also suggest the desirability of such.

Moreover, the Applicants have demonstrated that the cited prior art references teach against the desirability of the Examiner's purported modification. Specifically, one of ordinary skill in the art would not disregard the device specifically taught by Yokoyama as achieving the objects of its invention (See Yokoyama, Summary of the Invention, col. 2, lines 11-16). In other words, the modification proposed by the Office Action would, impermissibly, be contrary to teachings of Yokoyama.

The Applicants have also argued that even if one were to replace the Figure 2 beamsplitter device of Yokoyama with a rhombic prism, such a modification of the optical coupler device of Figure 3 would not result in an operative device because the light beams would not be propagated in the proper directions to enter the optical fibers. As such, the proposed modification of Yokoyama would impermissibly render Yokoyama unsatisfactory for its intended purpose and, therefore, there is no suggestion or motivation to make the proposed modification to render claim 3 obvious over the cited references.

Sec MPEP 2143.01; *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). It is submitted that the Office Action has failed to take note of the Applicant's argument and has failed to answer the substance of it. If the Examiner should repeat his rejection, the Examiner is requested to take note of the Applicant's argument and answer the substance of it. MPEP 707.07(f).

In conclusion, applicants respectfully submit that in view of the arguments set forth herein, the applicable rejections have been overcome.

If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Daniel Ovanezian at (408) 720-8300.

If there are any additional charges, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

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2/3/06
Date